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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,333	11/12/2003	Gerald Mulvaney	Gm0001	6031

7590

02/06/2006

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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,333	<b>Applicant(s)</b> MULVANEY, GERALD	
	<b>Examiner</b> Jeffrey G. Hoekstra	<b>Art Unit</b> 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

It is noted that the examiner renumbered the claims and considered them as follows:

Misnumbered claim 3 (the second occurrence) has been renumbered as claim 4.

Misnumbered claim 4 has been renumbered as claim 5.

Misnumbered claim 5 has been renumbered as claim 6.

Misnumbered claim 6 has been renumbered as claim 7.

Misnumbered claim 7 has been renumbered as claim 8.

Misnumbered claim 8 has been renumbered as claim 9.

Misnumbered claim 9 has been renumbered as claim 10.

Misnumbered claim 10 has been renumbered as claim 11.

Misnumbered claim 11 has been renumbered as claim 12.

Misnumbered claim 12 has been renumbered as claim 13.

Misnumbered claim 13 has been renumbered as claim 14.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependency of the claim is unclear in lieu of misnumbering.

4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependency of the claim is unclear in lieu of misnumbering.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Coulter et al (5657764). For claim 1, Coulter et al discloses an in-vivo lumen measurement device 1 comprising a flexible portion 2 having an distal expandable end 4 comprising a flexible membrane or balloon 6, a measuring portion 10 slidably disposed along said flexible portion, and proximal end 9 having a valve 20.

7. For claim 2, Coulter et al discloses distance markings 8 disposed on said flexible portion.

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8. For claim 3, Coulter et al discloses said flexible portion as a tube (column 5 lines 52-54).

9. For claim 4, Coulter et al discloses said distal expandable end increasing in size (column 5 lines 29-31).

10. For claim 5, Coulter et al discloses said proximal end 9 having a valve 20 configured to adapt and lock to an external device via fitting 11.

11. For claims 6 and 7, Coulter et al discloses proximal end 9 having a valve 20 allowing liquid or gas to enter said hollow flexible tube portion thereby expanding said expandable flexible membrane or balloon (column 5 lines 23-28).

12. For claim 8, Coulter et al discloses said measuring portion as a means for marking said distance markings (column 6 lines 3-5).

13. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasson (3706307). For claims 9-11, Hasson discloses a method of gynecological measuring comprising inserting a flexible tube 36 into a uterus until insertion terminates at the fundus (top) of the uterus, sliding a measuring portion 50 along said flexible tube until measuring portion is against the cervix, and determining the length of the uterus and/or cervical canal by the position of said measuring portion to the end of said flexible tube via markings 56 (column 3 lines 38-58).

14. For claims 12-14, Hasson discloses a method of gynecological measuring comprising inserting a flexible tube 36 into a uterus until insertion terminates at the fundus (top) of the uterus wherein the expandable end 48a, 48b is increased in size, withdrawing said tube until the expanded end is against the interior portion of the

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endocervical canal, sliding a measuring portion 50 along said flexible tube until measuring portion is against the cervix, and determining the length of the uterus and/or cervical canal by the position of said measuring portion to the end of said flexible tube via markings 56 (column 3 lines 38-58).

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH

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